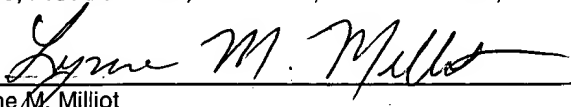


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Lynne M. Milliot

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

In re Application of:

Bart Alan MELTZER et al.

Application No. 09/173,858

Confirmation No. 4734

Filed: 16 October 1998

Title: **Documents for Commerce in Trading
Partner Networks and Interface Definitions
Based on the Documents**

Group Art Unit: 2178

Examiner: HUYNH, Cong Lac T.

CUSTOMER NO. 22470

MAIL STOP APPEAL BRIEF - PATENTS
COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, VA 22313-1450

TRANSMITTAL OF APPEAL REPLY BRIEF

Sir:

In connection with the above-referenced U.S. patent application, enclosed herewith is the following document:

☒ **Appeal Reply Brief**

The Commissioner is hereby authorized to charge any fees in relation to this document to our Deposit Account No. 50-0869 (Attorney Docket No. JGR 1004-1).

Respectfully submitted,

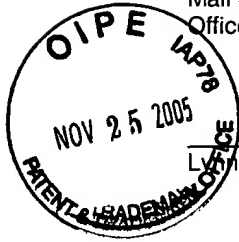
Dated: 22 November 2005


Ernest J. Beffel, Jr., Reg. No. 43,489

HAYNES BEFFEL & WOLFELD LLP
P.O. Box 366
Half Moon Bay, CA 94019
Telephone: (650) 712-0340
Facsimile: (650) 712-0263

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MAIL STOP APPEAL BRIEF - PATENTS

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

APPEAL REPLY BRIEF

Sir:

This Appeal Reply Brief is filed in support of Appellants' appeal from the Office Action mailed 18 April 2005 in this case and in response to the Examiner's Supplemental Answer mailed 22 September 2005.

Should it be determined that any fees are required with regard to the filing of this document, the Commissioner is hereby authorized to charge those fees to Deposit Account No. 50-0869.

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I. CHANGED IDENTIFICATION OF REAL PARTY IN INTEREST

During the pendency of the appeal, this application was reassigned to the newly formed Open Invention Network, led by Jerry Rosenthal, CEO. Mr. Rosenthal is former vice president of IBM's Intellectual Property and Licensing business. See, <http://www.openinventionnetwork.com>.

II. AGREED POINTS

The Examiner's Supplemental Answer (hereafter "ESA") acknowledges Appellants' statement identifying the real party in interest, the lack of related appeals or interferences, the status of the claims, the status of amendments after final, the summary of invention and the issues on appeal. It also acknowledges the copy of appealed claims in the appendix.

III. GROUPING OF CLAIMS

The ESA is unclear about acknowledging the "VII. Grouping of Claims" statement on page 2 of the Opening Brief (OB). Appellants separately addressed two groups of claims, as indicated in the OB Table of Contents, items B.1-2 and B.3. The ESA presents arguments regarding many individual claims (ESA 3-14), and argues specifically regarding the groups represented by claim 1 (ESA 20) and claim 61 (ESA 22). Accordingly, the two groups of claims identified by Appellants have been fully briefed for the Board to address.

IV. REPLY TO EXAMINER'S ARGUMENTS

This reply focuses on the McKendrick reference, because the second WSCI reference serves only to connect XML to the claim wording, "respective descriptions of sets of storage units and logical structures for the sets of storage units." Appellants and Respondent agree that this wording reads on XML and XML reads on this wording. Accordingly, very little mention is made in this brief of WSCI's XML language specification/standard.

A. McKendrick is not available as a reference

As we argued in the opening brief, rejection of the claims is improper because it depends on McKendrick, which has been effectively removed as a reference by the declarations of record. On its face, the four inventors' testimony swears behind the

McKendrick reference. The inventors completed the claimed structure and method before March 11, 1998 and McKendrick was not published until the September, 1998 issue of Bank Technology News.

1. Rule 131 declarations are considered under relaxed standards

The Examiner's argument (ESA 14-17) does not include any direct rejoinder to this heading or the position that, because the inventors' testimony is presented in a Rule 131 declaration and not an initial oath or an interference proceeding, the Rule 131 standards apply. The parts of Appellants' position to which we can find a response involve the binding authority of *In re Carlson*, 79 F.2d 900, 27 USPQ 400 (CCPA 1935) (ESA 15) and the standard for corroboration (ESA 17).

The Examiner's statement argues (ESA 15) that *In re Carlson* should be distinguished on the basis that it dealt with former Rule 75, instead of current Rule 131. Belying the implied premise, the Examiner shows no significant difference between Rules 75 and 131. Judge Rich, writing a concurring opinion *In re Williamson*, 304 F.2d 673, 675, 134 U.S.P.Q. (BNA) 171 (CCPA 1961) recounted the PTO Solicitor's Office explanation there is not any significant difference between the old and new rules:

The solicitor's brief summarizes what has been said in many of the decisions in which former Rule 75 and present Rule 131 have been considered as follows:

*** The language of the rule and its interpretation through almost a century all combine to show that, while paragraph (b) of present Rule 131 is new, it merely incorporates the practice and construction which was considered implicit in the old rule.

Significantly, the current MPEP §715.05 at 700-257 (Ver. 8 rev. 3 Aug. 2005) cites *In re Carlson* as the controlling authority on signature of a Rule 131 declaration by fewer than all of the inventors. Following the case law and the MPEP, *In re Carlson* is controlling, despite superficial differences between Rules 75 and 131.

Regarding corroboration, the Examiner argues:

With respect to Appellant's arguments that corroboration is not necessary for a 131 affidavit or declaration, the Examiner agrees. Corroboration refers to independent witnesses. What the Examiner is noting is a deficiency of evidence rather than a deficiency in corroboration. Appellant must present sufficient evidence to the Examiner in order to show completion of the invention prior to the effective date of the reference. To date, the evidence submitted is not sufficient.

(ESA 17) The Examiner's argument (ESA 17 & 19) is confusing, as it first acknowledges that corroboration of a Rule 131 declaration is not required, then seems to demand an independent witness or full source code. It is black letter law that documents submitted with a declaration are evidence, and corroborating evidence at that. *See, e.g., In re Jolley*, 308 F.2d 1317, 1323-24, 13 U.S.P.Q.2d (BNA) 1313 (Fed. Cir. 1989) (e-mail corroborated conception date). Construed in the best light, the Examiner seems to argue whether the declarations successfully antedate the reference and remove it. We address the merits below.

2. No petition is required

The ESA was filed to supplant the Examiner's first answer, to concede that the Examiner's invocation of Rule 47 was mistaken. Appellants and Respondent now agree that Rule 47 has no application to these declarations.

A new argument on appeal proposes a Rule 182 petition to waive Rule 64, but cites no supporting authority:

When an affidavit or declaration is signed by less than all named inventors as stated above, 37 CFR 1.131 requires a showing of evidence (typically a petition under 37 CFR 1.182 requesting waiver [sic] of the rule (37 CFR 1.64)). Such showing is typically held to similar standards of a petition under 37 CFR 1.47, and is decided by the Office of Petitions. The Examiner has no authority to waive the requirements of Rule 131. A waiver of rule requires a petition under separate cover filed in the instant application which will then be forwarded to the appropriate deciding official.

(ESA 15) One can see that this is a new argument on appeal by comparing this passage with the Examiner's brief filed August 24, 2005, at 3-4 or by reviewing the Final Office Action.

There is no need in this case for a Rule 182 petition to waive Rule 64. Like Rule 47, Rule 64 applies to initial and supplementary oaths or declarations submitted to satisfy Rules 63 and 67, not to Rule 131 affidavits. Just as Rule 47 does not apply, neither does Rule 64. There is no need for a Rule 182 petition to waive Rule 64.

What the Examiner should have argued is that there is no applicable rule, since Rule 47 does not apply. Rule 182 is for questions not specifically provided for, rather than for suspension of rules. *Compare* Rule 183. Even the better argument fails, because MPEP § 715.08 (Rev. 3 Aug. 2005) expressly delegates authority over "question[s] of the sufficiency of affidavits or declarations under 37 CFR 1.31" to

Primary Examiners. This delegation includes the formal sufficiency and propriety of declarations and the merits of declarations, as § 715.08, by its words, covers both decisions subject to petition and those subject to appeal.

In this case, the declarations have been entered into the record, which makes them evidence to be considered on appeal. The MPEP's distinction between review of Rule 131 declaration decisions by petition or appeal is based on whether the declaration is entered into the record or not. From MPEP § 715.09 (Rev. 3 Aug. 2005):

Review of an examiner's refusal to enter an affidavit as untimely is by petition and not by appeal to the Board of Patent Appeals and Interferences. *In re Deters*, 515 F.2d 1152, 185 USPQ 644 (CCPA 1975); *Ex parte Hale*, 49 USPQ 209 (Bd. App. 1941). See MPEP § 715.08 regarding review of questions of propriety of 37 CFR 1.131 affidavits and declarations.

As for proper supervision of the case, both a Primary Examiner and a Supervising Primary Examiner (SPE) have endorsed the positions taken regarding the declarations by signing the Final Office Action, Examiner's Answer and Examiner's Supplemental Answer. Moreover, the Examiner of record has been advised by a TC 2100 Special Projects Examiner (SPRE), who, as a practical matter, would address a § 715.08 petition from refusal to enter the declarations in the record. As interview summaries indicate, counsel has discussed the Rule 131 issues in this appeal at length with SPRE Brian Johnson. Accordingly, case is ripe for review of the four inventor declarations against the standard set by *In re Carlson* or, alternatively, under *Ex parte Foster*, 1903 C.D. 213, 105 O.G. 261 (Comm'r Pat. 1903), which does not require even one inventor to sign a factual declaration about an actual reduction to practice.

3. The declarations satisfy *In re Carlson* and *Ex parte Foster*

The Respondent does not dispute that Appellants have satisfied the declaration signing requirements of Rule 131 as interpreted in MPEP § 715.04, *citing In re Carlson*. The remaining argument on appeal (ESA 15) is whether *In re Carlson* applies, to which we responded above. Under *In re Carlson*, the declaration of Robert John Glushko, ¶ 8, satisfactorily explains the unavailability of co-inventor Mr. Allen and attaches a copy of the Express Mail label addressed to Mr. Allen's last known address, which was returned by the Post Office marked "Refused". This testimony matches the case law pattern for showing unavailability of a Rule 131 declarant. Based on the proof of

record, the signatures of four inventors are sufficient to satisfy Rule 131, as interpreted in MPEP § 715.04 (Rev. 3 Aug. 2005), and *In re Carlson*.

Moreover, *Ex parte Foster* does not require even one of the inventors to sign an affidavit witnessing the actual reduction to practice, much less all of the inventors. The PTO's guidance to examiners, MPEP § 715.05 (Rev. 3 Aug. 2005), cites both *In re Carlson* and *Ex parte Foster* as authority to be relied on during examination.

4. The evidence shows completion of the invention before March 11, 1998, which is well before publication of the September, 1998 issue of Banking Technology News

The Examiner once again argues (ESA 19), that

Exhibit A, submitted as a written description, does not constitute an actual reduction to practice. Furthermore, only the filing of a US patent application which complies with the disclosure requirement of 35 USC 112 constitutes a constructive reduction to practice. A written description, no matter how complete, which has not been made the subject of a US patent application, does not qualify as reduction to practice. Accordingly, Applicants have not established prior invention. The rejection is maintained.

We already responded at length to this argument (OB 6-8), without provoking any rejoinder. Our unremarkable premise was that testimony under oath is evidence.

Again, the inventors declared that:

Prior to March 11, 1998, we had implemented a registry for trading partners. The registry was used in a method, also implemented prior to March 11, 1998, in a form sufficient to demonstrate that the method would work for its intended purpose, for establishing transactions among trading partners in a network, comprising: maintaining a registry of machine-readable specifications specifying business services offered by trading partners, the machine-readable specifications including at least one of definitions of, and references to definitions of, services offered and at least one of definitions of, and references to definitions of, documents to be exchanged with such services by trading partners; and providing, in response to a request, one or more of the machine-readable specifications from said registry is via a communication network to a requesting node.

Claim 1 reads:

*An interface for transactions among nodes in a network including a plurality of nodes which execute processes involved in the transactions, the interface being stored in a computer readable medium, comprising:
a machine readable specification of an interface to transaction processes stored in memory accessible by at least one node in the network,*

including interpretation information providing a definition of an input document, and a definition of an output document, the definitions of the input and output documents comprising respective descriptions of sets of storage units and logical structures for the sets of storage units.

On its face, the quoted evidence reads on Claim 1. In addition, the opening brief explains the corroboration found in Exhibit A. (OB 6-8)

The Examiner's most direct response is:

Applicant's attorney can not argue that the evidence provided in the Exhibit A supports the claimed limitations. The evidence and facts must be either stated in the declaration or incorporated by reference thereto. In this case, the evidence and declaration combined fail to provide support for the above identified claimed limitations, thus failing to show prior completion of the invention.

(ESA 17) This argument introduces a false distinction between evidence and declarations. It would prohibit argument as a way of explaining what a document means. In short, the Examiner's position is contrary to law.

When the declaration evidence and corroborating written evidence are evaluated from the perspective of one skilled in the art, the declarations read on the claims and are effective to remove the McKendrick reference, on which the Examiner relies for every rejection.

For this reason, the rejections should be reversed.

B. It was improper to reject the claims as unpatentable under section 103(a) over McKendrick in view of W3C, Extensible Markup Language (XML) 1.0, 2/10/98, pages 1-37 ("XML Language Recommendation").

Four years ago, Applicants called on the Examiner to comply with MPEP § 2144.03 (Rev. 3 Aug. 2005) and provide evidence of what the Examiner considers "well-known." See, Response to Official Action (mailed January 2, 2002). The required Examiner's affidavit has never been provided. Making new statements on appeal as to what was "well-known" does not avoid the Examiner's burden of supplying an affidavit to prove and put in context what is really "well-known".

Now, on appeal, the Examiner would imply or infer every element of claim 1¹ and the claim as a whole, because the reference McKendrick is too thin to read on any part of the claim. Let's focus on part of claim 1, "*a machine readable specification of an*

¹ The same is true for claim 61, as explained below. For claim 61, the Examiner actually admits that none of the elements of the claim are expressly taught!

interface to transaction processes stored in memory accessible by at least one node in the network, including interpretation information providing a definition of an input document, and a definition of an output document". The Examiner implies from McKendrick an interface. (ESA 20, line 4). From the words "purchase order" and "invoice", the Examiner implies that the interface is for a process that accepts purchase orders as input and produces invoices as output. (ESA 20, lines 5-6) The Examiner infers from use of XML a machine readable specification of the implied interface to the implied process. (ESA 20, lines 8-9) She further infers that the inferred machine readable specification must be stored in memory of a server accessible by at least one node. (ESA 21, lines 19-21) From the Examiner's own logic (really, from Appellants' claim), the Examiner constructs the claim as a whole. (ESA 20, lines 13-16). After we reproduced in the opening brief the cited text from McKendrick, the Examiner fled from the test of the reference to a web of implications and inferences.

It offends sensibility for a section 103 rejection to be based on implying or inferring **every** element of the claim **and** the claim as a whole. We suggest that the Examiner's analysis be rejected without any detailed analysis, on the basis that a section 103 rejection is improper when it depends on implying or inferring **every** element of the claim **and** the claim as a whole from a wholly inadequate reference. The teaching of McKendrick's two page trade press report is not enough to support the rejections on appeal, assuming *arguendo* that McKendrick is available as a reference.

1. Rejection of claim 1 was improper because McKendrick does not read on the claim

The Examiner's argument (ESA 20, lines 17-21) responding to the opening brief (OB 9-12) begins with a flawed paraphrase of the opening brief. The argument that follows (ESA 21-22) does not respond to the opening brief in any recognizable way.

To get past the brevity of McKendrick, Appellants pointed out where the full article briefly quoted in McKendrick might be found. If the McKendrick quotes really implied as much as the Examiner tries to infer, surely the Examiner would have found the words she needed in the full article instead of having to make them up. The Examiner ignored our invitation to review the full article which McKendrick excerpts.

We explained at length (OB 9-12) why McKendrick does not inherently imply the claimed interface and tied our explanation to the Examiner's argument. The Examiner

repeated her argument (ESA 21), cut and pasted from the Final Office Action, instead of responding to Appellants. We refer this Board to the opening brief, rather than lengthening this brief by repeating our position.

For these reasons, McKendrick does not read on claim 1, the Respondent's arguments should be overruled and the rejection of claim 1 should be reversed.

2. Rejection of claim 1 depends on impermissible hindsight

The ESA full-heartedly, with gusto, took up McKendrick's suggestion to build a future system (not then in existence, "will allow ... to be implemented") using the claim as a blueprint, and exercising 20-20 hindsight, which is impermissible. 2-5 Chisum on Patents § 5.03 [2][c] n. 29 (2005 Lexis version); *see, e.g. ATD Corp. v. Lydall, Inc.*, 159 F.3d 534, 546, 48 USPQ2d 1321, 1329 (Fed. Cir. 1998) ("Determination of obviousness cannot be based on the hindsight combination of components selectively culled from the prior art to fit the parameters of the patented invention."); *Grain Processing Corp. v. American Maize-Products Corp.*, 840 F.2d 902, 907, 5 USPQ2d 1788, 1792 (Fed. Cir. 1988) ("Care must be taken to avoid hindsight reconstruction by using 'the patent in suit as a guide through the maze of prior art references, combining the right references in the right way so as to achieve the result of the claims in suit.' "). Despite the positions taken in our opening brief, the ESA boldly implied and inferred the system described in a 113-page application accompanied by 16 figures from a few words in a two-page trade press article. The web of implications and inferences impermissibly used claim 1 as a blueprint and engaged in hindsight to hypothecate from McKendrick's few words to a whole system. No rejoinder to our position appears in the ESA – no variation on the "hindsight" appears anywhere in ESA.

We raised the black letter law that requires references relied upon for a section 103 rejection to provide an enabling disclosure and explained why McKendrick does not teach or enable any machine-readable specification of an interface. (OB 11-12) There was no rejoinder – no variation on the "enabling" appears anywhere in ESA.

In the absence of an enabling disclosure, this Examiner resorted to hindsight, which is grounds for reversal of the rejection of claim 1.

3. Rejection of claim 61 was improper because McKendrick does not read on the claim

The Examiner's argument regarding claim 61 (ESA 22) is brief, as was the argument in our opening brief. We made the point that the Examiner's rejection of claim 61 begins by admitting that McKendrick does not read on the claim, because the final office action at 14-15, began, "McKindrick [sic] **does not disclose** explicitly ... defining a machine readable definition of an input document for a node in the network including resources to execute a process in the transaction, and a machine readable definition of an output document for the node, the definitions the input and output documents comprising respective descriptions of sets of storage units and logical structures for the sets of storage units". The ESA responds, "This is not completely true", then repeats the same words that we used in the opening brief – there is no practical difference between what the parties say about the Examiner's sweeping admission in the final office action. The ESA completely ignored our position that, because hindsight reconstruction is impermissible, the Examiner's words that McKendrick "does not disclose" what is claimed make a good argument for reversal.

For lack of rejoinder and because the Examiner admittedly implies or infers **ALL** of elements of claim 61 **AND** the claim as a whole, the rejection of claim 61 should be reversed.

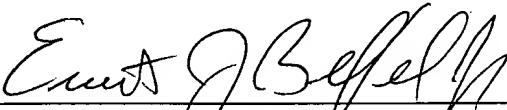
V. CONCLUSION

In view of the foregoing, Appellants ask that this honorable Board reverse the Examiner's rejections of the claims. In addition, it is submitted that all claims that are the subject of this examination are now allowable, and a notice of intent to issue a patent is respectfully requested.

The Commissioner is hereby authorized to charge any fee determined to be due in connection with this communication, or credit any overpayment, to our Deposit Account No. 50-0869 (File No. JGR 1004-1).

Respectfully submitted,

Dated: 22 November 2005


Ernest J. Beffel, Jr., Reg. No. 43,489
Attorney for Patent Owner

HAYNES BEFFEL & WOLFELD LLP

P.O. Box 366
751 Kelly Street
Half Moon Bay, CA 94019
Telephone: 650.712.0340
Facsimile: 650.712.0263